UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/816,665	04/02/2004	Roger Wiles	40101/00102	1035

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EXAMINER
VU, THONG H

ART UNIT	PAPER NUMBER
2616	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/22/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

	Application No.	Applicant(s)
Office Action Summary	10/816,665	WILES ET AL.
	Examiner	Art Unit	
	Thong H. Vu	2616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>02 April 2004</u>.

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>33-51</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>33-51</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

1.   Claims 33-51 are pending.

Double Patenting

2.   The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees.   A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

        A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

        Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 33-51 are rejected on the ground of nonstatutory double patenting over

claims 1-32 of U. S. Patent No. 6,738,829 B1 ('829) since the claims, if allowed, would

improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the

patent and is covered by the patent since the patent and the application are claiming

common subject matter, as follows:

('829) 1. A software package for operating on a network including a plurality of network hardware devices, comprising:	(Application) 42. A network device, comprising:
at least one networking protocol to transmit and receive data packets over the network; a hardware device driver communicatively	an enhanced network driver receiving a data packet from upper level layers, inserting a source address in the data packet

coupled to a first network hardware device; an enhanced network driver communicatively coupled to the hardware device driver to transmit and receive the data packets using the first network hardware device; and	and determining the destination address for the data packet, the enhanced network driver being independent of any hardware services for the network device; and
a control interface to transmit and receive control information to and from the hardware device driver;	a control interface communicating control information from the upper level layers to a hardware device driver,
at least one of the enhanced network driver and control interface being separately portable from the other one of the enhanced network driver and control interface to a second network hardware device.	the control interface being independent of any data packets in the network device and including a plurality of object definitions

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 33-51 are rejected under 35 U.S.C. 102(b) as being anticipated by Dobbins et al [Dobbins 5,485,455].

3.   As per claim 33 Dobbins discloses A network switch, comprising:

a look-up table [Dobbins, the connection table look-up, col 8 lines 6-21]; and

an enhanced network driver [Dobbins, software embedded devices as firmware, col 6 lines 20-25] receiving a first data packet received by the network switch [Dobbins, router, col 8 lines 6-21] from a network device and determining a port number of the network switch which received the first data packet and an address of the network device from the first data packet [Dobbins, port and address, col 8 lines 6-21], the enhanced network driver storing the port number and the corresponding address in the look-up table, and wherein the enhanced network driver, when receiving a second data packet to be transmitted to the network device, determines the port number from which the second data packet is transmitted based on the address included in the second data packet and the corresponding port number stored in the look-up table for the address [Dobbins, look-up table, port, address, col 8 lines 6-21].

4.   As per claim 34, Dobbins discloses the address is the MAC address of the network device [Dobbins, MAC address 314, Fig 7C-2].

5.   As per claim 35, Dobbins discloses the enhanced network driver receives the first data packet from a network driver for the network switch [Dobbins switch 86, Fig 7B].

6.   As per claim 36, Dobbins discloses the enhanced network driver receives the second data packet from an upper level layer of the network switch [Dobbins switch 86, Fig 7B].

7.   As per claim 37, Dobbins discloses the address of the network device is determined by extracting the address from the first data packet [Dobbins, extract address, col 15 lines 16-31].

8.   As per claim 38, Dobbins discloses the enhanced network driver identifies a protocol of the first data packet and the first data packet is sent to an upper level layer based on the protocol [Dobbins, router, col 8 lines 6-21].

9.   As per claim 39, Dobbins discloses the enhanced network driver sets a port indicator to the port number corresponding to the address [Dobbins, port, col 8 lines 6-21].

10.   As per claim 40, Dobbins discloses when the look-up table does not include a corresponding port number for the address, the enhanced network driver sets a port indicator to all port numbers of the network switch [Dobbins, look-up table, col 8 lines 6-21].

11.   As per claim 41, Dobbins discloses the network switch is an Ethernet-type switch [Dobbins, Ethernet, col 13 lines 55-60].

12.   As per claim 42 Dobbins discloses A network device, comprising:

an enhanced network driver receiving a data packet from upper level layers,

inserting a source address in the data packet and determining the destination address

for the data packet, the enhanced network driver being independent of any hardware

services for the network device [Dobbins, unique MAC address assigned to each

system, col 3 lines 25-37]; and

a control interface communicating control information from the upper level layers

to a hardware device driver [Dobbins, software embedded devices as firmware, col 6

lines 20-25], the control interface being independent of any data packets in the network

device and including a plurality of object definitions [Dobbins, look-up table, port,

address, col 8 lines 6-21].

13.   As per claim 43, Dobbins discloses each of the object definitions is one of a

Management Information Base object definition and a user defined object definition

[Dobbins, MIB, Fig 10].

14.   As per claim 44, Dobbins discloses the communication of the control information

by the control interface includes receiving a request from the upper level layers,

accessing the object definition corresponding to a hardware device included in the

request and passing the request to the hardware device driver [Dobbins, router, col 8

lines 6-21].

15.   As per claim 45, Dobbins discloses the communication of the control information

further includes receiving a response to the request from the hardware device driver

and passing the response to the upper level layers [Dobbins, router, col 8 lines 6-21]..

16.   As per claim 46, Dobbins discloses the network device is one of a network

switch, a network interface card, a router, an internet appliance and a personal

computer [Dobbins, internet, col 1 lines 35-45].

17.   As per claim 47 Dobbins discloses A method for processing a data packet,

comprising the steps of:

        receiving the data packet at a hardware device driver [Dobbins, software

embedded devices as firmware, col 6 lines 20-25];

        passing the data packet to an enhanced network driver, the enhanced network

driver being independent of any hardware device functionality [Dobbins, unique MAC

address assigned to each system, col 3 lines 25-37];

        processing the data packet by the enhanced network driver, the processing

including the determining of a source address of the data packet and a port number of a

hardware device which received the data packet [Dobbins, look-up table, port, address,

col 8 lines 6-21];

        storing the source address and the corresponding port number in a look-up table

[Dobbins, Fig 3];

        identifying a protocol type of the data packet [Dobbins, Fig 6]; and

passing the data packet to an upper level layer based on the identified protocol

type [Dobbins, switch, router, col 8 lines 6-21].

18.   As per claim 48, Dobbins discloses the source address is a MAC address

[Dobbins, MAC address 314, Fig 7C-2].

19.   As per claim 49, Dobbins discloses receiving a second data packet at the

enhanced network driver from one of the upper level layers [Dobbins, router, col 8 lines

6-21];

        determining if the second data packet has a broadcast destination; and

addressing the second data packet to be transmitted from all data ports of the

hardware device [Dobbins, broadcast, col 16 liens 39-col 17 line 3].

20.   As per claim 50, Dobbins discloses determining a destination address of the

second data packet; determining if the destination address is stored as a source

address in the look-up table; and directing the second data packet to the port number

corresponding to the   source address in the look-up table when the destination

address matches the source address [Dobbins, router, col 8 lines 6-21].

21.   As per claim 51, Dobbins discloses the protocol type is an Internet Protocol

[Dobbins, internet, col 1 lines 35-45].

Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner *Thong Vu*, whose telephone number is (571)-272-3333. The examiner can normally be reached on Monday-Thursday from 6:00AM- 3:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, *Failed Lynn*, can be reached at (571) 272-2092. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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